

### **REMARKS**

Claims 1-9, 11-22, 24-28 and 30-33 are pending. Claims 1, 14, and 27 are amended to more particularly point out the differences between the present invention as claimed and the cited references. Claims 7, 20, and 32 are canceled. Reconsideration of the claims is respectfully requested based on the above amendments and the following arguments.

#### **35 U.S.C. § 103 Rejections**

Claims 1-9, 11-22, 24-28 and 30-33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watanabe et al. (U.S. Patent No. 6,850,757) and Mousseau et al. (U.S. Patent Application Publication No. 2002/0120696). Applicants respectfully traverse this rejection.

Watanabe, alone or in combination with Mousseau, does not teach or suggest the present claims. With respect to the Examiner's argument regarding teaching away, Applicants disagree with the Examiner's analysis. The Examiner states

A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. (citations omitted).

However, the rejection is not based on an anticipation analysis, but on an obviousness analysis.

In an obviousness analysis, teaching away disclosed in the primary reference is applicable. See MPEP 2145.D.1 ("A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered when determining obviousness; however, the nature of the teaching is highly relevant and must be weighed in substance." (emphasis added, internal quotations and citations omitted)). In addition, the claimed invention must be considered as a whole when determining obviousness. See MPEP 2141.02.

Furthermore, the Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various noted factors only "can" or "might" be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S.

1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996).

Considered as a whole, Watanabe discloses a notification apparatus that notifies a user of a cellular phone of the arrival of an electronic mail when that user is away from the office. See Abstract; see also col. 1, lines 27-67. Nowhere does Watanabe contemplate downloading the “remainder of the electronic message” as in the present claims. At best, Watanabe discloses that a small piece of the arrived message may be transmitted to the user’s cellular phone, if the phone is capable of displaying such piece. See col. 6, lines 17-32. This transmission is not the full message and the transmission does not enable the user to download the remainder of the message.

Watanabe does not teach providing the user with a subset of the electronic message to allow the user to download electronic message of interest for viewing at the wireless portable device as claimed. The Examiner states that Watanabe discloses “to advise a user when an electronic message is received and to provide the user with a subset of the electronic message to allow the user to download electronic message of interest for viewing at the wireless portable device” through the following reference:

After determining whether the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 establishes a connection to the communication vender mail server 105 through the LAN 101 and the Internet 104 (ST409). Here, it is assumed that the IP address of the communication vender mail server 105 is preset to the mail notification apparatus 100. Since the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 transmits an arrival notification mail for the multipart mail to the cellular phone mail address 303 in the mail account data currently being read (ST410). In other words, the mail notification apparatus 100 notifies, by using electronic mail, the cellular phone mail address 303 in the mail account data currently being read, of the arrival of an electronic mail and the fact that the electronic mail is a multipart mail. More specifically, the mail notification apparatus 100 sends a predetermined

(standard) message with a fixed form to the cellular phone mail address 303b "09023456789@xxx.co.jp", corresponding to "Saburo.Matsushita" 301b, to notify the arrival of an electronic mail and the fact that the electronic mail is a multipart mail. The standard message includes a couple of short sentences, such as "An electronic mail has arrived. The arrived electronic mail is a multipart mail. The cellular phone 106 displays the message on a display portion, such as a LCD display, and so on. Col. 5, lines 6 – 31 (the Examiner also cites col. 2, lines 54-60).

However, nowhere in the above passage is the user provided with a subset of the electronic message to enable the user to download the electronic message of interest for viewing at the wireless portable device as claimed. Watanabe discloses sending a separate electronic mail message to a user to notify that an email has arrived in the user's account. Applicants direct the Examiner's attention to the content of the arrival email: "The standard message includes a couple of short sentences, such as 'An electronic mail has arrived. The arrived electronic mail is a multipart mail.'" This is not a subset of the electronic message received that allows the download of the message as claimed.

Furthermore, Watanabe teaches away from the present claims by disclosing "the user of the cellular phone 106 can take some necessary actions, for example, can read the arrived (received) electronic mail **at a PC in the place away from his/her office.**" Col. 5, lines 35 – 39 (emphasis added). This is directly opposed to "allow[ing] the user to download electronic message of interest **for viewing at the wireless portable device**" as claimed. Nowhere does Watanabe disclose that the complete message may be downloaded for viewing at the cellular phone.

Additionally, Watanabe also does not exist in the paradigm of pushing messages to electronic devices. Watanabe requires separate structure to retrieve emails at predetermined intervals. For example, Watanabe does not disclose "said mail server automatically forwards using standard mail protocols the copies of the received messages to the said notifications server." The Examiner's citation, however, teaches the opposite:

FIG. 1 is a schematic view illustrating a network on which a mail notification apparatus 100 operates, according to an embodiment of the present invention. As shown in FIG. 1, the mail notification apparatus 100 of the present invention is, for example, provided on a LAN 101 built in a company. A local mail server 102 and local mail clients 103, each of which is embodied, for example, as a PC, and so on, are connected to the LAN 101. The mail notification apparatus 100 is

further connected to the Internet 104 via the LAN 101. Thus, **the mail notification apparatus 100 of the present invention is capable of accessing a mail server 105 of a communication vender** (hereinafter "communication vender mail server"). The local mail server 102 receives an electronic mail from the Internet 104 via the LAN 101. Then, the local mail server 102 stores the received electronic mail into a mailbox corresponding to a mail address of the electronic mail. The local mail client 103 accesses the local mail server 102, at a predetermined time or in response to a predetermined instruction. When an electronic mail is stored in a corresponding mailbox, the local mail client 103 retrieves the electronic mail. Thus, the local mail client 103 can receives an electronic mail from the Internet 104. On the other hand, the communication vender mail server 105 performs wireless communication of electronic mail data with a cellular phone 106 according to a communication protocol specialized for the communication vender. Thus, the cellular phone 106 can transmits/receives an electronic mail to/from the Internet 104. In the network as described above, **the mail notification apparatus 100 notifies the cellular phone 106 of the arrival of the electronic mail stored in the mailbox of the local mail server 102.** Hereinafter, the electronic mail to notify the arrival of an electronic mail is called an "arrival notification mail". The configuration (construction) and the control of the mail notification apparatus 100 is explained below. Col. 2, lines 24 – 60 (emphasis added).

Applicants respectfully direct the Examiner to the following reference and citation:

As described above, if the transmission of the arrival notification mail is set, the mail notification apparatus 100 monitors whether a predetermined period has elapsed. When the predetermined period has elapsed (ST401), the mail notification apparatus 100 establishes a connection to the local mail server 102 (ST402). It is assumed that an IP address of the local mail server 102 is previously set to the mail notification apparatus 100. Col. 3, line 63 – col. 4, line 3; see also col. 4, lines 4 – 41.

At no time does the mail server forward the received email, or a subset of the email message, to the notification server. In Watanabe, the notification server establishes the connection, reads a record of mail account data, logs in the mail account, and sends a query to the local mail server. See col. 4, lines 4 – 41. As stated by Watanabe, "[in] other words, the mail notification apparatus 100 determines whether the mailbox corresponding to "Taro.Matsushita" 301 stores an electronic mail." The mail server in this process performs no action, especially not forwarding copies of the received messages to the notifications server as claimed.

Furthermore, Watanabe does not teach “said notifications server, upon generation of said subset, is configured to automatically transmit without any user trigger.” Watanabe states a user trigger is necessary:

To make the mail notification apparatus 100 transmit the arrival notification mail, **presetting is required**. In other words, when a user of the local mail client 103 is going out, **the user is required to set the mail notification apparatus 100 to request for transmitting the arrival notification mail to the cellular phone 106**. To set the request for transmitting the arrival notification mail, flags are provided in the HD section 208, for example. By checking the value of the flags, the mail notification apparatus 100 can know of who needs transmission of mail notification mail. Although it is not shown in FIG. 3, the flags can be included in the mail address conversion table 300. Col 3, lines 43 – 54 (emphasis added).

In the Examiner’s rebuttal, the Examiner states “[t]he court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” Office Action, p. 11. However, Watanabe does not disclose a manual activity for downloading the remainder of an electronic mail message because there is no equivalent capability in Watanabe’s invention. This is not a case of simply replacing manual activities with automatic means. The present invention as claimed operates in a different paradigm from the one Watanabe exists in.

For the above reasons alone, Applicants respectfully submit that Watanabe does not disclose the present invention as claimed. Accordingly, Applicants request withdrawal of this rejection.

Mousseau does not cure Watanabe’s deficiencies. Mousseau, which exists in a different paradigm from Watanabe, alters the operation of Watanabe. Mousseau “is directed toward the field of replicating (or synchronizing) information folders between a host system and a mobile data communication device.” p. 1, para. [0003]. Mousseau requires a folder at a host system and a folder at the mobile device so that the data items may be synchronized between the systems. Watanabe describes explicitly or inherently no such capability. The cellular phone in Watanabe does not utilize folders or storage system disclosed within Mousseau. Combination with Watanabe requires not only for Watanabe to change the principle of querying a mail server for the status of a message, but to adopt Mousseau’s data hierarchy and replication scheme.

Mousseau also does not disclose generating a subset of an electronic message. The Examiner states “Mousseau generat[es] a copy of said electronic mail message, therefrom, a subset of said received copy of said electronic mail message” is taught, in part, by:

Assuming that the redirector program 12 is activated, and has been configured by the user (either through the sensing of an internal, network or external event) to replicate certain user data items (including messages of type A or C) to the mobile device 24, when the message A is received at the host system 10, the redirector program 12 detects its presence and prepares the message for redirection to the mobile device 24. In preparing the message A for redirection, the redirector program 12 could compress the original message A, could compress the message header, or could encrypt the entire message A to create a secure link to the mobile device 24. Para. [0070]; see also para. [0076] and para. [0067].

However, the claims do not state “generating a copy of said electronic message.” The claims recite “said notifications server is for **automatically generating, therefrom, a subset of said received copy** of said electronic mail message.” Mousseau discloses a method/system that redirects exact copies (which is consistent with its scheme of synchronization of data folders) of email messages teaching away from the present invention as claimed. In addition, Mousseau disclose no capability that enables a user to select the subset of a message to download the remainder of a message.

Watanabe and Mousseau, alone or in combination, do not teach or suggest the present invention as claimed. Accordingly, Applicants respectfully request the withdrawal of this rejection.

## Conclusion

Applicants respectfully request the Examiner to reconsider the application based on the above arguments and allow the claims. In the event the Examiner requires further specificity to distinguish the asserted art, he is respectfully requested to call the undersigned to resolve any issues that remain before allowing this application to pass to issue.

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09/872,451

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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